

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 1-7, 13 and 15 have been amended and claims 20-22 have been added.

Claims 8-12 and 17-19 have been withdrawn from consideration, resulting in claims 1-7, 13-16, and 20-22 being pending and under consideration.

CLAIM OBJECTIONS AND 112 REJECTIONS

In view of the above amendments to claims 2, 4 and 6, it is respectfully requested that the outstanding objection to claim 6 and §112, second paragraph, rejection to claims 2 and 4 be withdrawn.

REJECTIONS UNDER 35 USC 102

Claims 1-3, 5, 7 and 13-16 stand rejected under 35 USC § 102(e) as being anticipated by Wallis et al., U.S. Patent Publication 2001/0051884. This rejection is respectfully traversed.

By way of only an example, referring to FIG. 4 and operation S111 of FIG. 5, in the present application, a customer can select one product to be repaired from a purchased product list 60 displayed at the customer-cellular phone 40. The purchased product list 60 can include at least a list number and a purchase number for each purchased product, and the user can create a repair request form including the purchase number indicated by the list number "01" and then send it to the service center 100, for example (paragraph 53). Further, the purchased product list 60 can be downloaded from the service center 100 (paragraph 53 and FIG. 7).

Accordingly, in a similar manner (but with differing scope and breadth), the independent claims have been amended to include the sending of at least a purchased product information and a purchase number to a customer terminal and receiving a repair request form including the purchase number from the customer terminal. See amended claims 1, 13 and 15. In addition, the retrieval of warranty information corresponds to the purchase number.

It is respectfully submitted that Wallis et al. fails to disclose the presently claimed invention, as amended.

In addition, new claims 20-22 correspond to previous claims 1, 13 and 15 but further include either the display and/or transmission of a purchased product list including at least a list number, a purchased product information, and/or a purchase number. It is respectfully

submitted that Wallis et al. similarly fails to disclose these claimed features.

REJECTIONS UNDER 35 USC 103

Claim 4 stands rejected under 35 USC § 103 as being obvious over Wallis et al., in view of Official Notice, and claim 6 stands rejected under 35 USC § 103 as being obvious over Wallis et al., in view of Lipton (Product traceability: A guide for locating recalled manufactured goods.) These rejections are respectfully traversed.

It is respectfully submitted that claims 4 and 6 are allowable at least for their dependency from allowable independent claim 1.

In addition, it is noted that the Office Action has taken Official Notice "of both the concept and the benefits of notifying the customer with the information on places, which are selectable, to receive a repaired product." The Office Action continues to discuss the "generally practiced concepts," as understood by the Examiner.

Thereafter, the Office Action concludes that the addition of the deficient features into Wallis et al. would have been obvious as "a gesture of goodwill to the customer to allow him the choice to pick up most convenient place of the available places to received the repaired item and this gesture of goodwill would help the suppliers to get repetitive business from the customer."

Similar to the above Official Notice, the proffered motivation provided in the rejection of claim 4 is further only the conclusion and opinion of the Examiner, not supported by the record.

First, the following is noted: "[i]t is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action," in addition, "an agency is not free to refuse to follow circuit precedent." In re Lee 61 USPQ2d 1430, 1434 (CA FC 2002).

Thus, the following precedent is binding in the present case.

Regarding Official Notice, on remand from the Supreme Court, the Federal Circuit in In re Zurko, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), reversed the decision of the Board of Patent Appeals and Interferences ("Board") to uphold a rejection under 35 USC §103 for lack of substantial evidence. Specifically, in Zurko and other recent decisions, the court criticized the USPTO's, both at the Board and Examiner level, reliance on "basic knowledge" or "common sense" to support an obviousness rejection, where there was no evidentiary support in the

record for such a finding.

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of **instant and unquestionable demonstration** as being well-known and only when such facts are of **notorious character and serve only to "fill in the gaps"** which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

Further, the applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion

In addition, as recited in In re Eynde, "we reject the notion that judicial or administrative notice may be taken of the state of the art. The fact constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice." In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

Lastly, it is improper to merely deem something obvious without any teaching/suggestion, or the taking of Judicial Notice. If the U.S. Patent and Trademark Office wishes to take Judicial Notice that the proposed structural and functional modification is notoriously well known, it is respectfully requested that supporting evidence be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

No such showing has been made in the present Office Action. It is submitted that the reason why no such showing was made is because the prior art of record individually or combined, fail to teach, suggest, or otherwise provide the motivation needed to make such a modification. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex Parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

Regarding the proffered motivation, despite the Office Action's attempt to evidence the

obviousness modification rationale by relying on an unsupported assertion of a common knowledge (or the Examiner's conclusion of what would make good business sense) in the art, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "**common knowledge**" and "**common sense**" may only be applied to the analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings.

Accordingly, it is respectfully submitted that the outstanding taking of Official Notice is improper and that the corresponding rejections fail to meet a prima facie obviousness case, noting that the rejection of claim 6 similarly relies on what the Examiner believes or has summarily concluded to be well known or make common "business" sense.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 4 and 6 be withdrawn and claims 4 and 6 be allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

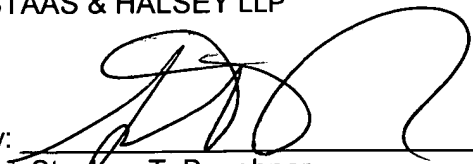
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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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